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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,060	03/02/2000	Andrew Scott Field	KDO.188020-1	5292
25763	7590	08/24/2006	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 08/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,5,8-11 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 8-11, and 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 2 and 5, canceled claim 6, and newly added claims 17-22. All pending claims (2, 5, 8-11, and 17-22) were examined in this final office action necessitated by amendment.

### ***Response to Arguments***

#### ***Pertaining to Rejection under 35 USC 103(a) in previous office action***

Applicant's arguments filed 31 May 2006 have been fully considered but they are not persuasive. Greulich and Real-time teach and suggest the claimed invention. Greulich teaches the system receiving from the customer files that contain images (e.g. logo graphics, form layout image data). Real-time specifically discloses online customer configuration, arriving at a real-time quotation, and then placing the order (please see Item U, page 2). A web browser that provides an application service, such as real-time quoting, that is delivering the application to the user via the browser interface is embedding code executable by the client computer.

The Examiner is suggesting the Applicant consider a telephonic interview for further discussion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 2, 5, 8-11, and 17-22 are rejected under 35 USC 103(a) as being unpatentable over Greulich (Paper #20050401, US 5,241,464) in view of Real-time (Paper #20050401, a collection of prior art cited in PTO-892, Items: U-W).**

Greulich teaches the creation and ordering of custom business forms on a customer computer and transmitting ordering parameters, design, and verbiage electronically to an order-receiving computer for the printing of business forms. Greulich teaches automatic price calculation at the customer's computer based on inputting ordering information (see at least abstract; Fig. 1 (15, 17, 18, 12, 27); Fig. 4 (40); col. 1, line 53 through col. 2, line 11). Greulich further teaches:

- *Providing a customer a pricing engine; displaying automatically the price quote at the customer:* pricing includes one or more printing configuration options selected by the customer; displaying on the customer computer (see at least Fig. 4 (46, 41); col. 6, lines 37-66); pricing system (see at least Fig. 8 (58); col. 8, lines 32-34).

- Customer providing image file: graphical representations; customer logo (see at least col. 5, line 21-28); customer providing image file (see at least Fig. 9ad; col. 9, lines 52-63).
- Color: (see at least Fig. 4 (INK); col. 3, line 19; col.6, line 54).
- Payment: paying by credit card, cash on delivery, or account (see at least col. 9, lines 35-51).
- Proofing: proofing before final production (see at least Fig. 1 (22); Fig. 10b (22, 76); col. 2, lines 12-27; col. 10, line 5); displays printed page layout graphically to customer electronically prior to customer finalizing order (please note examiner's interpretation: customer proofing the order) (see at least Fig. 9ab (W)).
- Automatically calculating a price quote based on the one or more printing configurations options selected by the customer: pricing engine automatically and substantially instantaneously calculated a new price quote (see at least Fig. 8 (58); Fig. 9b (64); col. 5, lines 45-49; col. 8, lines 32-67).
  - each time the customer selects or enters data for one or more new configuration options at the customer: (see at least Fig. 9b (64); Fig. 9c (Update Pricing); Fig. 9e (Update Pricing); col. 8, line 63 through col. 9, line 63).
  - before forwarding to the processing computer at a printing service provider: customer receives pricing updates to finalize the order

before printing service provider (e.g. separate production site) receives the order (see at least Fig. 1 (27, 28); Fig. 9ad; Fig. 10b (27, 28); Fig. 11 (27, 28); col. 6, lines 6-11; col. 9, lines 52 through col. 10, line 60).

Greulich teaches all the above as noted under the 103(a) rejection and teaches a) remote ordering of forms, and b) automatically and substantially instantaneously calculating a new price quote, but does not disclose a real-time web browser. Real-time teaches the explosive movement across multiple industries (e.g. electronic commerce, investment, or insurance) to real-time quoting over the Internet using web browsers (e.g. configure custom systems, arrive at a real-time quotation, and placing the order; real-time pricing quotes on stocks; real-time quotes for insurance) (U: see at least page 2; V: see at least page 1; W: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Greulich to implement Internet web browser-based real-time quoting as taught by Real-time, in order to provide faster response to customers conducting online transactions, and thereby increase sales.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,076,080 (Morscheck et al.) 13 June 2000; teaches online order entry of business forms, uploading of graphics, and automatic pricing calculations for custom print jobs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', with a stylized, flowing script.

Robert M. Pond  
Primary Examiner  
August 16, 2006